

### **REMARKS**

Applicants thank the Examiner for his helpful telephonic discussion with the undersigned agent on March 25, 2008, in which the Examiner and agent discussed the proposed addition of new claims 46-64. The substance of this discussion is described further below.

#### **The Amendments**

Applicants have amended the specification to set forth the priority claim to earlier filed applications as set forth in the Application Data Sheet submitted on February 7, 2005.

Applicants have cancelled claims 1-45, without prejudice, and expressly reserve their right to pursue the subject matter of the cancelled claims in one or more applications that claim priority under 35 U.S.C. § 120 from this application.

Applicants have added new claims 46-64. Support for these claims can be found in the application as filed, for example:

<u>Claim</u>	<u>Support</u>
46	Page 12, lines 7-10
47	Page 15, lines 11-12
48	Page 21, lines 14-28; Figure 21
49-52	Page 4, lines 3-5; page 7, lines 10-11 and lines 23-25; Figures 21 and 22
53	Page 3, lines 7-17
54-56	Page 3, lines 8-11
57	Page 15, lines 3-5
58, 59	Page 3, lines 16-17; page 14, lines 23-24; page 15, lines 3-6
60, 61	Page 3, lines 15-16; page 14, line 24
62	Page 8, lines 22-23; page 11; lines 19-20 and lines 26-29; page 12, lines 25-28; Figures 21 and 22
63	Page 9, line 32 – page 10, line 3; page 12, lines 25-28
64	Page 1, lines 16-18; page 2, lines 14-15; page 5, line 5 page 6, line 1; page 11, lines 15-17; Figure 8

No new matter is introduced by the amendments. Upon entry of the amendments, claims 46-64 will be pending in this application.

Applicants request entry of the amendments and consideration and allowance of the claims.

### **The Restriction Requirement**

The Examiner has required restriction of this application under 35 U.S.C. §§ 121 and 372 to one of the following groups:

- I. Claims 1-20, drawn to a method for down regulating a pre-selected endogenous gene, comprising administering a composition comprising a double-stranded RNA molecule;
- II. Claims 21-33, drawn to a method for down regulating a pre-selected endogenous gene, comprising administering a vector composition encoding an RNA transcript; and
- III. Claims 34-45, drawn to a method for treating a disease in a mammal, comprising applying a nucleic acid composition and a pulsed electric field.

The Examiner asserts that the inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

Applicants hereby elect the claims of Group I (claims 1-20) for initial substantive examination. During the March 25, 2008 telephonic discussion, Applicants proposed cancelling the pending claims and adding composition and method claims comprising a particular double-stranded RNA molecule that would read on the invention in Group I. The Examiner provisionally indicated that such an amendment would be acceptable. Accordingly, Applicants

elect the invention identified in Group I, have cancelled claims 1-20, without prejudice, and have added claims 46-64.

If the Examiner requires a further restriction between the newly added composition claims 46-61 and the method claims 62-64, Applicants provisionally elect claims 46-61 for initial substantive examination. Applicants make this election expressly without waiver of their right to file for and to obtain claims directed to the non-elected subject matter in continuing applications claiming priority and benefit herefrom, or, subject to allowance of the product claims, to rejoin the process claims depending from or otherwise including all the limitations of the allowable product claims in this application.

#### **Single Inventive Concept Election**

The Examiner is of the view that Groups I, II and III each contains claims directed to a plurality of inventions so that election of Group I necessitates a further election of a single type of dsRNA molecule (long or short) from claims 2-4; a single type of composition (polymeric or targeted synthetic vector) from claims 12-16; and a single type of mutated gene (coding or regulatory region) from claim 19. The Examiner asserts that each feature, listed above, represents a different special technical feature unique to the method comprising and/or requiring that feature.

Claims 46-64 refer to a single type of dsRNA (short) and no longer refer to different types of mutated genes, thus obviating the requirement for electing a single type of dsRNA molecule (long or short) or a single type of mutated gene (coding or regulatory region).


Claims 46-64 no longer refer to two types of compositions. Instead, the claims refer to a “polymeric synthetic nucleic acid carrier” (claim 53). Accordingly, Applicants believe the requirement for election and for identifying claims readable on the elected invention is obviated. However, if the Applicants have misunderstood the requirement, we stand ready to make an election.

Application No: 10/523,714  
Preliminary Amendment and Response dated April 4, 2008  
in Response to the Restriction Requirement dated October 4, 2007

### CONCLUSION

Applicants request favorable consideration of the application and early allowance of the pending claims. To that end, the Examiner is invited to telephone the undersigned to discuss any issue pertaining to this reply.

Respectfully submitted,



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